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HOFFMAN, WASSON & GITLER, P.C.
Suite 522
2361 Jefferson Davis Highway
Arlington, VA 22202

EXAMINER

KOSLOW, CAROL M.

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040527

Application Number: 09/935,721
Filing Date: August 24, 2001
Appellant(s): GAO, TAO, SHI

Christopher J. McDonald
For Appellant

EXAMINER'S ANSWER

MAILED

JUN 08 2004

GROUP 1700

This is in response to the appeal brief filed 21 April 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

The 35 USC 112 second paragraph rejection is withdrawn since appellant has defined the "bulk material" as meaning the carrier for the other components in the dispersion medium in the Brief

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6 and 12-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a magnetic dispersion medium comprising liquid paraffin, 1.5-3 wt% silica, 1.5-3 wt% titania, 0.001-0.005 wt% of a benzo oxazole fluorescent whitener and 13-20 wt% of electrical steel powder which contains up to 17 wt% manganese, does not reasonably provide enablement for a magnetic dispersion medium comprising a bulk material or liquid paraffin, a first and second colorant, a thickener and a magnetic material or iron powder. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The claims recite a magnetic dispersion medium comprising a bulk material, a first and second colorant, a thickener and a magnetic material. This encompasses compositions comprising any bulk material, colorants, thickeners and magnetic materials in any amounts, as long as the final product is a dispersion. However, the specification only teaches a magnetic dispersion medium comprising liquid paraffin, 1.5-3 wt% silica, 1.5-3 wt% titania, 0.001-0.005 wt% of a benzo oxazole fluorescent whitener and 13-20 wt% electrical steel powder which contains up to 17 wt% manganese. Such a limited disclosure does not support the breadth of the instant claims.

Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a magnetic dispersion medium comprising liquid paraffin, 1.5-3 wt% silica, 1.5-3 wt% titania, 0.001-0.005 wt% of a benzo oxazole fluorescent whitener and 13-20 wt% electrical steel powder which contains up to 17 wt% manganese, does not reasonably provide enablement for a magnetic dispersion medium comprising a bulk material, a benzo oxazole fluorescent whitener, a thickener and a magnetic material. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The claims recite a magnetic dispersion medium comprising a bulk material, a benzo oxazole fluorescent whitener, a thickener and a magnetic material. This encompasses compositions comprising any bulk material, thickeners and magnetic materials in any amounts and any amount of a benzo oxazole fluorescent whitener, as long as the final product is a dispersion. However, the specification only teaches a magnetic dispersion medium comprising liquid paraffin, 1.5-3 wt% silica, 1.5-3 wt% titania, 0.001-0.005 wt% of a benzo oxazole fluorescent whitener and 13-20 wt% electrical steel powder which contains up to 17 wt% manganese. Such a limited disclosure does not support the breadth of the instant claims.

Claims 1-6 and 10-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed composition is not taught or suggested by the specification. Line 24 on page 2 through line 2 on page 3 teaches a magnetic dispersion medium comprising liquid paraffin,

1.5-3 wt% silica, 1.5-3 wt% titania, 0.001-0.005 wt% of a benzo oxazole fluorescent whitener and 13-20 wt% electrical steel powder which contains up to 17 wt% manganese, where the steel powder has a particle size of less than 100 microns. This teaching does not support the claimed materials, where the amounts are not given and the composition is not limited to that disclosed in the specification.

(II) Response to Argument

Response to the arguments with respect to issue B:

Appellant argues that the magnetic dispersion medium art is a well-developed, predictable art. While this may be true, the specification is not directed to all magnetic dispersion mediums, as claimed, but to non-toxic magnetic writing screen dispersion mediums. Clearly the specification does not enable all the magnetic dispersions encompassed by the claims, which includes magnetic inks, fluorescent magnetic dispersion mediums used for inspection and fluorescent magnetic fluids. None of these listed dispersions can be used as a magnetic writing screen dispersion medium because they have properties different than those required for magnetic writing screen dispersion mediums. The fact one of ordinary skill in the art could determine what compounds that can be used in the claimed dispersion does not mean the specification enables the claimed composition, since the specification only enables the production of non-toxic magnetic writing screen dispersion mediums of a non-toxic dispersion liquid having a viscosity sufficient to prevent the magnetic particles from settling out, thickener, a white pigment, a fluorescent whitener and black or dark colored magnetic particles.

It is noted that the specification is also enabling for the production of non-toxic magnetic writing screen dispersion mediums of a dispersion liquid having a viscosity sufficient to prevent

the magnetic particles from settling out, a thickener, a white pigment, a fluorescent whitener and black or dark colored magnetic particles in addition to those set forth in the rejections. While this composition is broader in scope than the composition set forth in the above rejections, but is also much narrower in scope than the claimed compositions.

Response to the arguments with respect to issue C:

Appellant admit in the sentence staring in the last line of page 4 that the claims are broader than the composition disclosed in the specification. The first paragraph of 35 U.S.C. 112 requires that the "specification shall contain a written description of the invention". Thus claims that are broader than the specification clearly do not meet the written description of the specification.

While appellant is correct the claims do not have to be limited to the preferred embodiments, 35 USC 112 first paragraph requires that the claims cannot be any broader than the broadest composition disclosed in the specification. The broadest composition disclose in appellant's specification is a non-toxic magnetic writing screen dispersion medium of non-toxic dispersion liquid having a viscosity sufficient to prevent the magnetic particles from settling out, a thickener, a white pigment, a fluorescent whitener and black or dark colored magnetic particles. The phrase "magnetic writing screen dispersion medium" dictates the amount of each component. This is why amounts were not required in U.S. patents 4,143,472 and 6,419,498 (U. S. patent 5,419,498 cited by appellant is not to Ikeda et al and is directed to handling system: the correct number is 6,419,498), cited the Examiner in the office actions and by appellant in the Brief. The teachings in the background section with respect to the problems with the prior art and the listed object of the invention dictate that the dispersion liquid must be non-toxic and that the

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pigment must be white. The claims are clearly directed to magnetic dispersion medium which do not contain any of the compositional limitations disclosed by the specification, i.e. the function of the dispersion medium which dictated the amounts; that the medium is non-toxic, the presence of a white pigment which is not required by claims 10 and 11, and that the magnetic particles are dark colored or black.

The fact the Examiner did not enter the after final amendment does not show the weakness in this rejection. The amendment was not entered because the Examiner would have had to withdrawn the finality to enter new objections to the specification created by the proposed amendments to the specification. The created new objections to the specification raised a new consideration. It is proper not to enter after final amendments which raise a new consideration.

For the above reasons, it is believed that the rejections should be sustained

Respectfully submitted,


C. Melissa Koslow
Primary Examiner
Art Unit 1755

cmk
June 1, 2004

Conferees


Mark Bell


Patrick Ryan

HOFFMAN, WASSON & GITLER, P.C.
Suite 522
2361 Jefferson Davis Highway
Arlington, VA 22202